

Appl. No. 09/751,899

Amdt. Dated 7/8/04

Reply to Office action of April 21, 2004

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed April 21, 2004. In the Office Action, claims 1-21 were rejected. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

It is important to note that Applicant has failed to receive the signed SB-08 forms for two Information Disclosure Statements (IDSes) that were filed prior to the mailing of this Office Action. In particular, the first IDS was electronically filed on December 12, 2003, along with a hardcopy IDS submission of the publications. These IDSes were filed concurrently, so only a single filing fee was required. Applicant has received acknowledgement of receipt and consideration of the hardcopy IDS submission only. Moreover, the second IDS was filed on March 30, 2004, which included a hardcopy IDS and an eIDS collectively constituting a single submission. To date, no SB-08 forms have been received to acknowledge consideration of these references.

Therefore, Applicant respectfully requests confirmation from the Examiner that he has considered the hardcopy IDS and eIDS concurrently filed on December 12, 2003 as well as the hardcopy IDS and eIDS concurrently filed on March 30, 2004. Copies of these submissions are enclosed herewith as Exhibits A and B.

Rejection Under 35 U.S.C. § 103

Claims 1-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over England (U.S. Patent No. 6,330,670) in view of Adams (U.S. Patent No. 6,363,485) and Reardon (U.S. Patent No. 6,212,635). Claims 12-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over England in view of Adams. Applicant respectfully traverses these rejections in their entirety because a *prima facie* case of obviousness has not been established.

A. Claims 1-11

Applicant respectfully submits the combination of England, Adams and Reardon constitutes impermissible hindsight reconstruction. As aptly stated by the Federal Circuit in *In re Kotzab*, 217 F.3d 1365, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000), "to establish obviousness based on a combination of the elements disclosed in the prior art, *there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant.*" Emphasis added. Herein, Applicant respectfully submits that these references provide no motivation toward the recovery of a segment (e.g., second segment) of the BIOS using a combination key that is formed within the platform using keying materials from both a token and internally stored within the platform. Emphasis added. Applicant respectfully requests the Examiner to reconsider and withdraw the § 103(a) rejection.

Moreover, as the Examiner is aware, when evaluating a claim for determining obviousness, all limitations of the claims must be evaluated. See *In re Fine*, 873 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Herein, all of the limitations of the claims have not been fully evaluated because neither England nor Adams nor Reardon, alone or in combination,

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suggest every limitation set forth in the above-identified claims. For instance, the Office Action states that column 7, lines 45-62 of England teaches the operation to "decrypt a second BIOS area to recover a second segment of BIOS code." Applicant respectfully disagrees because these teachings (col. 7, lines 45-62) of England merely describe the general functionality of a CPU (140) having a pair of public and private keys (164). There is no teaching or suggestion anywhere in England or in the other cited references for decrypting a second BIOS area to recover a second segment of BIOS as claimed. This limitation is further refined by dependent claim 3.

Moreover, as set forth on pages 2-3 of the Office Action, Applicant agrees with the Examiner that England does not teach (1) "combining the first keying material with a second keying material internally stored within the platform in order to produce a combination key," and (2) "using the combination key to decrypt code." However, Applicant disagrees with the Examiner that Adams teaches these limitations. The particular section of Adams cited by the Examiner teaches the formation of a secret key (210) from partial encryption key seed data (218) and sampled biometric input data (224). The secret key (210) as described has no usage, whatsoever, for decrypting BIOS placed in an encrypted format as claimed. In contrast, the secret key (210) is output to another personal computer (212) or other suitable device that needs the secret key to decrypt encrypted data.

As set forth on page 3 of the Office Action, Applicant further agrees with the Examiner that the combination of England and Adams does not teach "releasing a first keying material from a token communicatively coupled to the platform in response to authenticating the user." However, Applicant disagrees with the Examiner that Reardon teaches this limitation. Given the lack of teaching of the limitations set forth above, Applicant reserves the right to submit further arguments in the event that the §103(a) rejection is maintained.

With respect to dependent claims 2-11, Applicant respectfully traverses these rejections as well. Most notably, with respect to claim 3, England (column 11, lines 30-63) does not disclose the loading a BIOS code including a first BIOS area and a second BIOS area. According to claim 3, the first BIOS area is an encrypted first segment of BIOS code and the second BIOS area is an encrypted second segment of BIOS code. Instead, England discloses the loading of the boot block and OS software components, which clearly are not encrypted segments of BIOS code as claimed.

In light of the foregoing, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-11 under 35 U.S.C. §103(a).

B. Claims 12-21

With respect to claims 12-21, a *prima facie* case of obviousness has not been established because all limitations of the claims were not evaluated. For instance, Applicant respectfully submits that there is no teaching of a "trusted platform module" being part of an integrated circuit device as set forth in claim 12. In addition, Adams fails to teach or even suggest producing a combination key by combining a first incoming keying material with a second keying material internally stored within the integrated circuit device (or trusted platform module

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or the platform itself) and to decrypt a second BIOS area to recover a second segment of BIOS code. Instead, Adams teaches production of a secret key (210) based on partial encryption key seed data (218) and sampled biometric input data (224), which has no applicability to recovery of data from BIOS.

Hence, there is no motivation or suggestion for the combination key being used to decrypt a second BIOS area as set forth in independent claims 12, 15 and 19, which is further defined in subsequent dependent claims as a segment of BIOS placed in an encrypted format. In fact, Adams teaches away from the invention because it involves *outputting* the secret key (210) to a personal computer (212) or other suitable device that needs the secret key to decrypt encrypted data. Emphasis added. It offers not suggestion of decrypting a specific segment of the BIOS code as claimed.

Hence, Applicant respectfully requests the Examiner to reconsider and withdraw the outstanding §103(a) rejection of Claims 12-21.

Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Dated: 7/8/04

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Susan McFarlane

7/8/2004

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